

gmg.

## Notice of Allowability

### Application No.

09/755,003

### Examiner

Daniel M Sullivan

### Applicant(s)

EGGAN ET AL.

### Art Unit

1636

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Paper filed 24 March 2004.
2. ☒ The allowed claim(s) is/are 1,4,5,7,14,17,18,20,27,29,30,42-44 and 46-48.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

Anne-Marie Falk  
ANNE-MARIE FALK, PH.D.  
LIBRARY EXAMINER

### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Helen Lee on 12 May 2004.

The application has been amended as follows:

In the claims

Cancel claims 35, 37 and 41.

Amend claims 1, 42-44 and 48 as follows:

1. A method of producing a mouse, wherein mouse non-inbred ~~pluripotent~~ ES cells are introduced into mouse tetraploid blastocysts by injection under conditions that result in production of an embryo and the resulting embryo is transferred into a ~~foster~~ pseudopregnant female mouse which is maintained under conditions that result in development of live offspring, ~~wherein said foster mother is a mouse.~~

42. A method of producing a mutant mouse that is derived from a single non-inbred ES cell clone, comprising breeding a mutant male mouse and a mutant female mouse, wherein the male

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mouse and the female mouse or an ancestor thereof were produced from the same non-inbred male ES cell clone and the female mouse is an XO female.

43. The method of claim 42, wherein the non-inbred ES cell clone is a non-inbred F1 cell clone.

44. A method of producing mouse XO F1 ES cells, comprising introducing into mouse male F1 ES cells a negative selection marker, under conditions appropriate for insertion of the negative selection marker in the Y chromosome of mouse ~~male~~-F1 ES cells, thereby producing a mixture of mouse ~~male~~-F1 ES cells comprising ~~male~~-F1 ES cells in which the negative selection marker ~~is~~ is inserted in the Y chromosome and other ~~male~~-F1 ES cells, some of which do not contain a Y chromosome; subjecting the resulting mixture to conditions that result in the death of ~~male~~-F1 ES cells in which the Y chromosome has the negative selection marker inserted therein and do not result in the death of ~~male~~-F1 ES cells that lack a Y chromosome and are XO F1 ES cells, thereby producing mouse XO F1 ES cells.

48. The method of claim 47, wherein the mutant XO female mouse or an ancestor thereof was derived from ~~an~~ a male mouse F1 ES cell by knocking out the Y chromosome of the F1 ES cell, thereby producing an XO F1 ES cell; introducing the XO F1 ES cell into a tetraploid mouse blastocyst under conditions that result in production of an embryo and transferring the resulting embryo into a foster mother which is maintained under conditions that result in development of live offspring, thereby producing an XO female offspring.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMS

*Anne-Marie Falk*  
**ANNE-MARIE FALK, PH.D.**  
**PRIMARY EXAMINER**